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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/688,867

10/17/2003

Francesco Stellacci

P-8698-US

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EXAMINER

YANG, NELSON C

ART UNIT

PAPER NUMBER

1641

MAIL DATE

DELIVERY MODE

08/04/2009

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

<p align="center">Advisory Action Before the Filing of an Appeal Brief</p>	<p>Application No. 10/688,867</p>	<p>Applicant(s) STELLACCI ET AL.</p>	
	<p>Examiner Nelson Yang</p>	<p>Art Unit 1641</p>	

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 13 July 2009 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☐ The period for reply expires _____ months from the mailing date of the final rejection.
b) ☒ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
(a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);
(b) ☐ They raise the issue of new matter (see NOTE below);
(c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☐ Applicant's reply has overcome the following rejection(s): _____.
6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. ☐ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
The status of the claim(s) is (or will be) as follows:
Claim(s) allowed: _____.
Claim(s) objected to: _____.
Claim(s) rejected: _____.
Claim(s) withdrawn from consideration: _____.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing a good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because:
See Continuation Sheet.
12. ☐ Note the attached Information *Disclosure Statement*(s). (PTO/SB/08) Paper No(s). _____
13. ☐ Other: _____.

/Nelson Yang/
Primary Examiner, Art Unit 1641

Continuation of 11. does NOT place the application in condition for allowance because: applicant's arguments are not found persuasive.

With respect to applicant's argument on p. 2-3 that the combination of Liang and Guire would remove an element of Guire so as to make it unoperable, the Office disagrees. Rather the Office notes that Liang was introduced as a simple substitution of one known technique for another to accomplish the same goal of binding to a substrate, and wherein the substitution would be an improvement. More specifically, Guire et al. utilizes the multi-ligand conjugates as a means to immobilize specific binding ligands such as nucleic acids to a second support which may comprise glass (column 16, lines 35-48) in a known spatial arrangement, whereas Liang et al. merely provides a method for doing so in a more flexible and efficient manner and one that is compatible with the supports of Guire et al. Since applicant merely alleges that removing the linkers of Guire et al. would render it inoperable, but has not shown why or how it would render the invention inoperable, applicant's arguments are not found persuasive.

With respect to applicant's arguments on p. 3-4 that Guire or Liang et al. do not disclose a method demonstrating the details for such disassociation and binding, the Office notes that the method recited in the claims do not recite the details involved in disassociation and binding, and merely recites the terms themselves, without further disclosing specific features involved. The fact that applicant discusses such limitations, such as the force used to disassociate the first ligands, or the chemistry involved appears to suggest that applicants are referring to limitations that were not recited in claims. In response to this argument that the prior art fails to disclose these features of applicant's invention, it is noted that the features upon which applicant relies (i.e., thiol groups, application of specific forces) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). Since the prior art does disclose binding and disassociation, which are all that are recited in the claims, applicant's arguments are not found persuasive. In addition, if the process of disassociation and binding between two supports is as complex as applicants have suggested, applicants may indeed wish to further clarify their invention as recited in the claims as to avoid having the claims encompass inoperative embodiments.

With respect to applicant's arguments on p. 4-5, that there is no disclosure in Guire or Liang that Si-linker DNA molecules as described by Liang can be bound to a second substrate while at the same time their DNA part is attached to another molecule which is bound to a first substrate. The prior art can be modified or combined to reject claims as prima facie obvious as long as there is a reasonable expectation of success. In *re Merck & Co., Inc.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986) (Claims directed to a method of treating depression with amitriptyline (or nontoxic salts thereof) were rejected as prima facie obvious over prior art disclosures that amitriptyline is a compound known to possess psychotropic properties and that imipramine is a structurally similar psychotropic compound known to possess antidepressive properties, in view of prior art suggesting the aforementioned compounds would be expected to have similar activity because the structural difference between the compounds involves a known bioisosteric replacement and because a research paper comparing the pharmacological properties of these two compounds suggested clinical testing of amitriptyline as an antidepressant. The court sustained the rejection, finding that the teachings of the prior art provide a sufficient basis for a reasonable expectation of success.); *Ex parte Blanc*, 13 USPQ2d 1383 (Bd. Pat. App. & Inter. 1989) (Claims were directed to a process of sterilizing a polyolefinic composition with high-energy radiation in the presence of a phenolic polyester antioxidant to inhibit discoloration or degradation of the polyolefin. Appellant argued that it is unpredictable whether a particular antioxidant will solve the problem of discoloration or degradation. However, the Board found that because the prior art taught that appellant's preferred antioxidant is very efficient and provides better results compared with other prior art antioxidants, there would have been a reasonable expectation of success.). Since Liang et al. does teach that the Si-linker DNA molecules can be bound to a substrate via the silane, and to another nucleic acid via the DNA molecule, and Guire et al. teach that the second nucleic acid may be connected to another substrate, and since applicant has not provided any evidence showing why the molecule of Liang et al. would not be capable of functioning as the multi-ligand conjugate of Guire et al., one of ordinary skill in the art at the time of the invention would have had a reasonable expectation of success in utilizing the molecule of Liang et al. in the method of Guire et al.

Applicant's arguments with respect to claims 40 and 97 appear to refer to their prior arguments, which have been discussed above.

For these reasons, applicants arguments have not been found persuasive, and the rejections have been maintained.